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UP-1771

EXPRESS MAIL LABEL NO. EL600640844US

PATENT REISSUE APPLICATION

Docket No. 11527.209.2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue application of

Per Just Andersen, Ph.D., et al.

Serial No. 09/390,583

Filed: September 2, 1999

For: COATED STARCH-BASED COMPOSITIONS
AND METHODS FOR MANUFACTURING
STARCH-BASED COMPOSITIONS

Examiner: Blaine R. Copenheaver

Art Unit
1771DECLARATION UNDER 37 C.F.R. § 1.175(b)(1)
IN SUPPORT OF REISSUE APPLICATION

1. We, Per Just Andersen, Ph.D., and Simon K. Hodson (hereinafter "Inventors"), declare that we are the original and sole inventors named in previously filed U.S. application Serial No. 08/327,524, filed October 21, 1994, which issued as U.S. Patent No. 5,662,731 on September 2, 1997, and for which this application for reissue is sought. We further declare that we are citizens of the Kingdom of Denmark and the United States of America, respectively, and have residences and post office addresses at 947 Via Fruteria, Santa Barbara, California 93110 and 4621 Via Roblada, Santa Barbara, California, 93110, respectively. We believe ourselves to be the original, first, and joint inventors of the subject matter of the invention or discovery set forth in said U.S. application Serial No. 08/327,524, which issued as said U.S. Patent No. 5,662,731, and which is the subject of U.S. reissue application Serial No. 09/390,583.

2. E. Khashoggi Industries, LLC (hereinafter "Assignee"), by and through its President, Simon K. Hodson, declares that it is the assignee of the entire right, title and interest in and to U.S. Patent No. 5,662,731, which issued from U.S. application Serial No. 08/327,524, as evidenced by the assignment documents recorded at reel 7371, frame 813 (original assignment from inventors to E. Khashoggi Industries) and reel 8761, frame 333 (subsequent assignment from E. Khashoggi Industries to E. Khashoggi Industries, LLC).

3. The Inventors and Assignee together constitute the "Applicants" of this application for reissue. Applicants have reviewed the aforementioned assignment documents and believe that title is in Assignee seeking to take action.

4. Applicants acknowledge the ongoing duty to disclose information which is material to the examination of this reissue application in accordance with Section 1.56(a) of Title 37 of the Code of Federal Regulations.

5. Applicants believe that U.S. Patent No. 5,662,731 is wholly or partly inoperative by reason of Applicants having claimed less than what Applicants had the right to claim.

6. Every error in the patent which has been corrected in the present reissue application by way of the amendment filed concurrently with this Declaration, which is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of Applicants.

7. Applicants, when drafting and filing the original claims, and when drafting and filing subsequent amendments during prosecution, sought to protect what they considered to be their invention. In particular, Applicants received protection for a starch-based composition as recited in issued claim 1, which reads as follows:

1. A starch-based composition for molding into an article having a starch-bound cellular matrix, the starch-based composition comprising water, a starch-based binder in a concentration greater than about 20% by weight of the starch-based composition, and a fibrous material having an average fiber length greater than about 2 mm and an aspect ratio greater than about 10:1, wherein the fibers are substantially homogeneously dispersed throughout the starch-based composition, wherein the starch-based binder includes a substantially ungelatinized component comprising unmodified starch granules in an amount in a range from about 50% to about 90% by weight of the starch-based binder and a substantially gelatinized component comprising gelatinized starch in an amount in a range from about 10% to about 50% by weight of the starch-based binder prior to molding the composition into the article.

8. It was originally believed that the foregoing claim, as well as the other claims of U.S. Patent No. 5,662,731, adequately protected the invention for which patent protection was sought.

9. Subsequent to the issuance of U.S. Patent No. 5,662,731, Applicants began considering whether claiming the disclosed composition as a composite that includes two distinct regions, namely a starch-based composition in a first region and a coating composition in a second region, would better protect Applicants against infringement by others.

10. In particular, Applicants realized that an infringer could theoretically circumvent the invention disclosed in U.S. Patent No. 5,662,731 and avoid literal infringement of the claims in view of the unnecessarily restrictive fiber length limitation recited in the issued claims.

11. Therefore, since the claims of U.S. Patent No. 5,662,731 do not recite compositions in a manner fully disclosed in the original specification, *i.e.* as a composite that includes a starch-based composition in a first region and a coating composition in a second region, but unnecessarily restrict the length of the fibers used in the starch-based region, they may not provide adequate claim protection against a potential infringer. As such, the claims that issued in U.S. Patent No. 5,662,731 appear to be at least partially inoperative.

12. Both Applicants and Applicants' attorneys failed to appreciate the inventive nature of using the coating compositions disclosed in U.S. Patent No. 5,662,731 in combination with the

broader aspects of the disclosed starch-based compositions so as to form a new composite composition of unique chemistry and chemical properties, though the Inventors were clearly in possession of this invention at the time the application was filed.

13. Only after issuance of U.S. Patent No. 5,662,731 did Applicants and Applicants' attorneys realize that Applicants could have claimed novel composite compositions that included many aspects of the claimed starch-based compositions in combination with coating compositions disclosed in the specification.

14. If, during the pendency of U.S. application Serial No. 08/327,524, Applicants had fully understood their right to claim the composite compositions recited in the claims as now presented, Applicants could have sought protection for this invention, either instead of the claims that were actually issued, or in a continuation application that could have been filed during the pendency of said U.S. application Serial No. 08/327,524 was still pending.

15. The claims for which patent protection is now being sought appear to be within the scope of the invention that was elected during the pendency of U.S. application Serial No. 08/327,524.

16. During a telephone conversation between the Examiner and John M. Guynn on November 1, 1995, Applicants elected a class of starch-based compositions that were broadly defined by originally-filed claim 1, which, at the time, read as follows:

1. A starch-based composition comprising a starch-based binder in a concentration greater than about 20% by weight, and a fibrous material having an average fiber length of greater than about 2 mm and an aspect ratio of at least about 10:1, wherein the fibers are substantially homogeneously dispersed throughout the composition.

17. As a result of this election, as evidenced by original claim 1, Applicants elected to prosecute on the merit claims directed to "starch-based compositions" that, at a minimum, included

only two components: (1) "a starch-based binder" (*i.e.* gelatinized or ungelatinized native or modified starch) and (2) "a fibrous material".

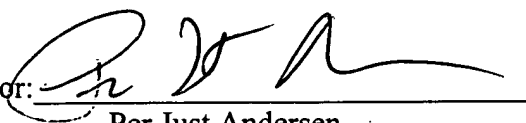
18. The elected starch-based compositions did not require the inclusion of water, which can be added in amounts sufficient to make them plastic and deformable, but included both aqueous and non-aqueous starch-based compositions, as clearly evidenced by originally filed claim 17, which was pending at the time of the election and which read as follows:

17. The composition of claim 1, *further comprising water* in a concentration from about 15% to about 80% by weight.

(Emphasis added.)

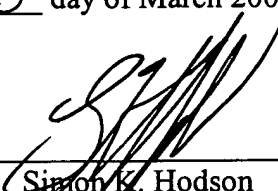
19. We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the reissue application or any patent issuing thereon.

Signed at Santa Barbara, California this 23rd day of March 2000.

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Signed at Santa Barbara, California this 23rd day of March 2000.

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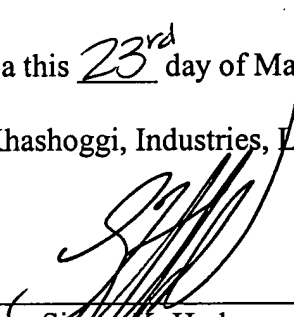
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E. Khashoggi, Industries, LLC (Assignee)

By: _____


Simon K. Hodson

President

JMG:cm

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